

## REMARKS

The claims under consideration are 22, 26-37, and 39. The independent Claims 22 and 37 were previously amended by Amendment C of 31 July 2003 to make clear that the machine direction stretchability of the biaxially stretchable breathable laminate of the present invention is achieved by creping without the use of intermediate mechanical fixing steps. All Claims stand as finally rejected under 35 USC § 103 under the combination of Benson (6,129,801) and Morman '028 (5,883,028) and, for Claim 39, further in view of Roe (5,554,143). Applicants respectfully request reconsideration of all rejections.

### Claim Rejections - 35 U.S.C. § 103

Applicants have previously amended the independent Claims 22 and 37 to make clear that the machine direction stretchability of the biaxially stretchable breathable laminate of the present invention is achieved by creping without the use of intermediate mechanical fixing steps.

Applicants have previously noted that the intermediate mechanical fixing steps as taught in Benson represent additional processing over the presently claimed inventions which consist essentially of the materials stated in the limitations.

As noted, such additional processing as taught in Benson can lead to an increased chance of changing the structure and mechanical properties of a nonwoven web. Applicants noted that it would be clear to a person of skill in the art that such change or damage may result in loss of the designed-in performance of the initial web, including structural strength, loft, porosity, or other physical factors including the hand or feel of the material. The feel of the material is cited by the Office as motivation for combining the cited art. The Applicants' reasoning against the plausibility of the motivation to combine is dismissed as speculative and not accorded the weight of a declaration. However, the point of the argument by Applicants was not to prove that additional processing must result in the changed fabric. Rather, the point is that a person having ordinary skill in the art would discount the combinability of the cited references to achieve the proffered motivation (i.e. good hand) given by the Office Action for combining the references. Applicants' arguments make clear

that the proffered motivation for combining the references to achieve the claimed invention is impermissibly informed by the teachings of the present invention, rather than being properly suggested by the references themselves. Accordingly, it is respectfully requested that the present rejections be reconsidered and withdrawn.

Further with respect to Claims 29-35 (limiting the invention to specific mechanical properties), it is noted that the Detailed Action refers to the present claim limitations as “reasonably presumed” to be met by a combination of the references. The Office Action of 01 May 2003 then placed the burden on the Applicants to refute this presumption. Applicants, as discussed above, pointed out that the mechanical processing steps of Benson can be assumed to alter the mechanical properties of the web undergoing such treatment. Thus, merely because the references teach the same starting materials as the Applicants, no inference can be drawn that the finished materials will have similar mechanical properties due to the additional mechanical processing steps of Benson. Thus, Applicants did meet the burden of refuting the presumption of similar mechanical properties of the resulting laminates. Accordingly, it is respectfully requested that the present rejections be reconsidered and withdrawn.

Claim 39 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Morman '028 in view of Benson and Roe. It is the contention of the Office that because Roe teaches an absorbent article having a waist feature that includes a structural elastic-like film that may be prestretched to give the material added bulk, such a material would be desirably combined with the teachings of Roe and Benson to make obvious the present invention. Applicants have pointed out that, in contrast, the motivation of present invention for pre-stretching a film is to provide machine direction stretch to a resulting laminate. Thus, the suggested combination of references do not provide motivation from the references themselves to make such a combination. The suggestion that added bulk would be desirable for a biaxial stretch laminate does not come from the references, but from a *post hoc* rationalization made with the present invention firmly in mind. It is therefore respectfully requested that the present rejection be reconsidered and withdrawn.

In their Amendment C, Applicants requested clarification of the statement in the Office Action of 01 May 2003 with respect to Claims 29-35, that the claim limitations are presumed to be met by “a combination of the three references” and noted that Claim 39 appears to be addressed only by paragraph 4 of the Detailed Action and not the paragraph 3. Per the Office Action of 23 December 2003, Applicants now believe that two references (Benson and Morman ‘028) are under discussion for rejection of Claims 29-35. Applicants respectfully note that the written record is of interest to both Applicants and the public in establishing the scope of the patent rights. Applicants therefore respectfully reserve the right to further address the rejections in so far as necessary to clarify the written record.

#### **Request for Telephonic Interview**

Clearly, there are differences between the present invention and the cited references involving patentable subject matter. These differences are now believed by the Applicants to be properly defined in the present Claims. The Examiner is requested to call Applicants’ attorney (per the provisions of M.P.E.P. § 713) to discuss any further problems or suggest solutions in defining the present invention in order to expedite the case towards allowance before issuing a final Office Action.

### Conclusion

Applicants believe that this case is now in condition for allowance. A notice to that effect is earnestly solicited. If the Examiner feels that any issues remain upon consideration of the present amendment, the Examiner is invited to contact Applicants' undersigned attorney to discuss the case.

Favorable consideration is requested.

Respectfully submitted,



Roland W. Norris

Reg. No. 32,799

Pauley Petersen & Erickson  
2800 W. Higgins Road, Suite 365  
Hoffman Estates, Illinois 60195  
PHONE (847) 490-1400  
FAX (847) 490-1403  
EMAIL [rnorris@ppelaw.com](mailto:rnorris@ppelaw.com)